Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: DWECK et al.

Application Serial No.: 10/016,673

Filing Date: October 30, 2001

For: SYSTEMS AND METHODS FOR FACILITATING ACCESS TO DOCUMENTS VIA A SET OF CONTENT SELECTION TAGS

Group Art Unit: 2167

Examiner: Lu, Kuen S

APPEAL BRIEF

Attorney Docket No.: G08.011

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Sir:

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the decision of the Examiner in the Office Action mailed October 3, 2005 (the "Final Office Action"), rejecting claims 1-26.

REAL PARTY IN INTEREST

The present application is assigned to GOLDMAN, SACHS & CO., 85 Broad Street, New York, New York 10004, U.S.A.

RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known to Appellants, Appellants' legal representative, or assignee, which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-26 are pending in this application. All pending claims stand rejected and are now being appealed.

STATUS OF AMENDMENTS

No amendments are pending.

SUMMARY OF CLAIMED SUBJECT MATTER

In certain environments, such as the financial industry, it may be helpful to search for existing information and/or to monitor information as it becomes available. According to some embodiments of the present invention, a content reader may define a set of "content selection tags," each tag being associated with a hierarchical tag domain (*e.g.*, Specification at page 11, lines 9-16 and FIGS. 2 and 4). It may then be arranged for the content reader to receive an indication of a document in accordance with the content selection tags that he or she defined. For example, a list of document titles representing documents that have tags similar to those in the content selection tag set might be displayed to the reader (*e.g.*, Specification at page 13, lines 2-23 and FIG. 11).

Moreover, the reader-defined set of content selection tags may be stored in connection with that reader (*e.g.*, Specification at page 14, lines 3-12). In this way, the content reader can periodically check and/or continuously monitor information without having to re-define his or her content selection tag set (or sets) of interest.

In some embodiments, a number of different content selection tag sets may be defined and named by a content reader. In addition, different portion's of a display presented to the content reader might be associated with different tag sets (*e.g.*, Specification at page 20, lines 13-29 and FIG. 11).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-2, 4-12, 15-19, 22, and 25-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Snow (U.S. Patent No. 6,098,066) in view of Anderson (U.S. Patent No. 6,510,434).

Claims 3, 13, 20, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Snow in view of Anderson and further in view of Husick (U.S. Patent No. 5,717,914).

ARGUMENT

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. See In re Rijckaert, 9 F.3d 1531,1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d1596, 1598 (Fed. Cir. 1988). Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d1626, 1630 (Fed. Cir. 1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir.1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g.,

C.R.Bard Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir.1998), cert. denied, 119 S. Ct. 1804 (1999). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not evidence. Thus, when an Examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45,61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Claims 1-2, 4-12, 15-19, 22, and 25-26

As an initial matter, the Examiner has not provided a reasonable motivation to combine Snow and Anderson in such a way as to result in the invention as recited in the claims. According to the Final Office Action:

> It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Anderson's teaching with the Snow reference because both references are directed to document searching and retrieving, and the combine teaching of the references would have enabled Snow's system to utilize [a] universal search vocabulary and support a document directory hierarchy such that an efficient and intelligent manner of query could have been performed.

Final Office Action at page 4, third paragraph. Appellants respectfully do not understand this motivation. The three portions of the references cited in support of the this logic are reproduced here for convenience:

> A method for searching a document directory hierarchy which partitions a user-initiated search. The document directory hierarchy comprises a plurality of document directories stored in a tree data structure. Each of the plurality of document directories corresponds to a category within a class hierarchy and stores at least one document. A user query comprising one or more search terms is accepted from an input device. If the user query includes a user-selected category, a directed search is performed. However, if the user query does not include a user-selected category, an undirected search is performed. The directed search confines the search to one of the plurality of document directories corresponding to the user-selected category, and returns relevant documents within the user-selected category. The undirected search is performed within each of the plurality of document directories within the document directory hierarchy, and returns

> relevant categories corresponding to document directories within the document directory hierarchy.

Snow, Abstract.

> The embodiments of the present invention provide for automatic document classification within user-defined categories. A user can then interactively search for documents according to search terms within the user-defined categories.

Snow at col. 1, lines 31-34.

> Accordingly, there is a need in the art for an improved method of searching that uses a universal search vocabulary. The method should eliminate ambiguity in the search request, focus the search on the most relevant information, perform the search in the most efficient manner and support searching multiple databases. The method should also support a hierarchy that can be used to query a user for additional search criteria in an efficient and intelligent manner.

Anderson at col. 2, lines 25-33.

Appellants respectfully suggest that these passages, and in fact the entirety of the references, in no way suggest modifying a system such as the one described in Snow to produce a method as recited in claim 1. Because there is no teaching or suggestion to modify the references in this way, a *prima facie* case of obviousness has not been established.

The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on the Appellants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The fact that references can potentially be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2143.01; In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH, 45 USPQ 2d 1977, 1981-82 (Fed. Cir. 1998) (the question to be asked is "whether the prior art contains a suggestion or motivation to combine references").

The absence of any motivation in the prior art (and the lack of a convincing line of reasoning) indicates that the Examiner has simply recognized a benefit provided by the present invention, and then used that benefit as a motivation to combine the references – the essence of impermissible hindsight reconstruction. The mere fact that an invention has a benefit is, of course, an insufficient reason to find it obvious.

In addition, and as admitted in the Final Office Action, neither Snow nor Anderson even disclose "storing the set of content selection tags in association with the content reader" as recited in claim 1 (*e.g.*, Final Office Action at page 4, fourth paragraph).

According to the Final Office Action, it would have been obvious to store the tag sets in association with the content reader because "Anderson extensively teaches utilizing system memory and disk drives for storage and running programs" along with the fact that multiple users may perform searches (Final Office Action at page 4, fifth paragraph). Appellants respectfully suggest that this completely fails to make "storing the set of content selection tags in association with the content reader" obvious.

The Final Office Action further states that the feature should be added to the references because:

> both references are directed to document searching and retrieving, and the combined teaching of the references would have enabled both ... systems to utilize the stored information [to] effectively identify the search terms and corresponding tags with users such that query result[s] could have been delivered to the users efficiently, and furthermore, the stored information would have eliminated the need for Snow system's user to repeat the same cycling steps of matching in the undirected and directed searches in [] future searches using the same terms.

Final Office Action at page 4, last paragraph to page 5, first paragraph. Once again, the Examiner is identifying a benefit of a claim element – and is then using that benefit to add the element to the prior art.

Because there is no teaching or suggestion to modify the references in this way, a *prima facie* case of obviousness has not been established. The rejection of these claims should be reversed. Also, there are separate grounds of patentability for at least one of the dependent claims, as argued separately below.

Claim 18

Claim 18 is dependent on claim 1 and adds the limitation storing the set of content selection tags "in association with a reader-defined name." For example, as illustrated in FIG. 4 of the present application, a reader might type a "Selection Tag Set Name" 440 via a graphical user interface to define the name and then activate a Save icon 445 to store the set of content selection tags in association with that name.

In addition to the reasons set forth above with respect to claim 1, the Final Office Action indicates that the addition of this limitation would have been obvious because "the stored information would have been known to the specific user" (Final Office Action at page 10 last paragraph). The Examiner is again thinking of a benefit provided by a claim element and is then using that as a reason to add the element to a reference.[1]

It is respectfully submitted that even if claim 1 were not found to be patentable, independent grounds of patentability exist for claim 18. The rejection of claim 18 should be reversed.

Claim 19

Claim 19 is dependent on claim 1 and adds the limitations of establishing and storing a "second set of content selection tags" for the content reader. For example, as illustrated in FIG. 9 of the present application, a content reader might define a first set of content selection tags identified as "STS-1001" and a second set of content selection tags identified as "STS-1002." In this way, a content reader can later access different types of pre-defined searches monitor different types of information (*e.g.*, one saved search set might be directed to a particular stock while another saved search set is directed to particular region of the world).

According to the Final Office Action, the fact that the system described in Snow includes multiple information categories and selections tags "does provide a teach for multiple sets of

[1] The Final Office Action also makes the argument that because a user can define a name for a file category (*e.g.*, a document folder) is an "equivalent teaching for further combining with the selection tags taught by the Anderson reference" (Final Office Action at page 24, second full paragraph). Appellants respectfully do not understand this.

selection tags" and that the teaching is further enhanced by the disclosure of "selection of appropriate categories, altering the search terms and re-running of the search" (Final Office Action at page 24, last full paragraph). Appellants respectfully suggest that any disclosure of multiple categories and/or tags in Snow in no way discloses a plurality of saved tag sets for a content reader as recited in claim 19.

It is respectfully submitted that even if claim 1 were not found to be patentable, independent grounds of patentability exist for claim 19. The rejection of claim 19 should be reversed.

Claim 20

Claim 20 is dependent on claim 19 and adds the limitations of having a "first portion of a reader display" associated with the first set of content selection tags and a "second portion of the reader display" associated with the second set of content selection tags. For example, as illustrated in FIG. 11 of the present application, the left side of a screen might display the results of a first pre-defined search (named "Sherlund and Microsoft") while the right side displays the results of a second pre-defined search (named "Greene and Pepsi").

According to the Final Office Action, Husick discloses such a feature in FIG. 4B (Final Office Action at page 16, first paragraph). Appellants respectfully disagree and suggest that all of the portions of the display illustrated in FIG. 4B are associated with a single search (e.g., "Who was James Doohan?" as illustrated in FIG. 4A).

Moreover, the Final Office Action states that such a limitation would have been obvious because Anderson displays query results "sorted and displayed by selection criteria or view terms to the user" (Final Office Action at page 25, first paragraph). No matter how a query result is displayed in Anderson, however, it is directed to a single set of selection tags and, therefore, does not disclose or suggest different portions being associated with different sets of content selection tags as recited in claim 20.

Appellants also note that this limitation would serve no purpose in Snow, Anderson, or Husick. Those references are directed to systems in which a user finds a particular pre-existing item of information of interest (e.g., "Who was James Doohan?") whereas the present invention

may be used to monitor types of information (defined by a reader) as it becomes available (e.g., certain types of financial information associated with a particular industry).

It is respectfully submitted that even if claim 19 were not found to be patentable, independent grounds of patentability exist for claim 20. The rejection of claim 20 should be reversed.

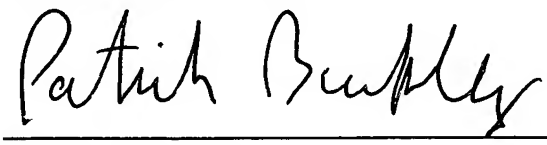
CONCLUSION

The rejection of claims 1-26 is improper at least because all of those claims recite limitations that simply are not taught or suggested by any of the references.

As required by 37 CFR §41.37(a)(1), this Brief is filed within three months from the date of mailing of Appellants' Notice of Appeal along with a one month extension of time. If any additional fees are due in conjunction with this matter, the Commissioner is hereby authorized to charge them to Deposit Account 50-1852.

If any issues remain, or if the Examiner or the Board has any further suggestions for expediting allowance of the present application, kindly contact the undersigned using the information provided below.

Respectfully submitted,



April 3, 2006
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Appendix A - Claims
Appendix B – Evidence
Appendix C - Related Proceedings

APPENDIX A - CLAIMS

This is a complete copy of the claims involved in the appeal:

1. A method of facilitating access to documents, comprising:

receiving information from a content reader;

establishing a set of content selection tags based on the received information, each content selection tag in the set being associated with a hierarchical tag domain;

arranging for the content reader to receive an indication of a document in accordance with the set of content selection tags; and

storing the set of content selection tags in association with the content reader .

2. The method of claim 1, wherein at least one tag domain comprises a multi-level domain, and at least one domain level is associated with a plurality of content selection tags.

3. The method of claim 1, wherein at least one content selection tag is associated with at least one of: (i) a content author, (ii) a content date, or (iii) a content type.

4. The method of claim 1, wherein at least one content selection tag is associated with at least one of: (i) a sector, (ii) an industry, (iii) a research type, (iv) a company, (v) an issuer, (vi) a region, (vii) a country, (viii) an investment product, (ix) security, (x) a third-party rating, (xi) a research analyst, (xii) a strategist, (xiii) an event type, (xiv) a subject, (xv) an investment style, (xvi) a market cap, (xvii) a document type, (xviii) an information value, or (xix) a currency.

5. The method of claim 1, wherein said receiving comprises:

receiving an indication of the set of content selection tags via a graphical user interface.

6. The method of claim 1, wherein content selection tags are further associated with Boolean operations in accordance with the information received from the content reader.

7. The method of claim 1, wherein the set of content selection tags is adapted to facilitate selection of the document in accordance with a set of document tags.

8. The method of claim 7, wherein the set of documents tags are established in accordance with information received from a content publisher via a graphical user interface.

9. The method of claim 7, wherein document tags are associated with hierarchical tag domains substantially similar to the tag domains associated with the set of content selection tags.

10. The method of claim 7, wherein at least one document tag comprises at least one of: (i) a primary tag, or (ii) a secondary tag.

11. The method of claim 7, wherein the document comprises content to be provided to a user via a communication network.

12. The method of claim 11, wherein the communication network comprises at least one of: (i) the Internet, (ii) an intranet, (iii) a public network, (iv) a public switched telephone network, (v) a proprietary network, (vi) a wireless network, or (vii) a local area network.

13. The method of claim 11, wherein the document comprises at least one of: (i) text content, (ii) image content, (iii) audio content, or (iv) executable content.

14. The method of claim 11, wherein the content comprises at least one of: (i) financial information, (ii) financial news, (iii) information about financial events, (iv) investment information, or (v) market information.

15. The method of claim 7, further comprising:

transmitting the document to the content reader.

16. The method of claim 15, wherein said transmitting is performed via at least one of: (i) a content controller, (ii) a content publisher, (iii) a content reader, (iv) a personal computer, (v) a server, (vi) a portable computing device, (vii) a wireless telephone, (viii) a Web site, or (ix) an electronic mail message.

17. The method of claim 7, wherein the set of content selection tags is associated with at least one of: (i) a content reader request, or (ii) an entitlement tag.

18. The method of claim 1, wherein the set of content selection tags is further stored in association with a reader-defined name.

19. The method of claim 1 , wherein the set of content selection tags comprises a first set of content selection tags and further comprising:

receiving additional information from the content reader;

establishing a second set of content selection tags based on the additional information; and

storing the second set of content selection tags in association with the content reader, wherein other sets of content selection tags are stored in association with other content readers.

20. The method of claim 19 , wherein the first set of content selection tags is associated with a first portion of a reader display and the second set of content selection tags is associated with a second portion of the reader display.

21. The method of claim 20, further comprising:

receiving from the content reader a selection of one at least of the first and second sets of content selection tags; and

transmitting to the content reader an indication of a document in accordance with the selected set of content selection tags.

22. The method of claim 18, further comprising:

receiving additional information from the content reader; and

storing a modified set of content selection tags in association with the content reader and the reader-defined name based on the additional information.

23. A computer-implemented method of facilitating access to investment research documents, comprising:

receiving from a content reader an indication of a first content selection tag set via a graphical user interface, the first content selection tag set being adapted to facilitate identification of a first investment research document in accordance with a first document tag set;

storing the first content selection tag set in association with a first reader-defined name;

receiving from the content reader an indication of a second content selection tag set, the second content selection tag set being adapted to facilitate identification of a second investment research document in accordance with a second document tag set;

storing the second content selection tag set in association with a second reader-defined name;

arranging for an indication of the first investment research document to be displayed via a first portion of a content reader display; and

arranging for an indication of the second investment research document to be displayed via a second portion of the content reader display.

24. An apparatus, comprising:

a processor; and

a storage device in communication with said processor and storing instructions adapted to be executed by said processor to:

receive information from a content reader,

establish a set of content selection tags based on the received information, each content selection tag in the set being associated with a hierarchical tag domain,

arrange for the content reader to receive an indication of a document in accordance with the set of content selection tags, and

store the set of content selection tags in association with a reader-defined name.

25. The apparatus of claim 24, wherein said storage device further stores at least one of: (i) a tag database, (ii) a document database, or (iii) a content reader database.

26. The apparatus of claim 24, further comprising:

a communication device coupled to said processor and adapted to communicate with at least one of: (i) a content publishing device, (ii) a document storage device, (iii) a content controller, (iv) a content reader device, or (v) a payment device.

APPENDIX B - EVIDENCE

No evidence is submitted herewith (*i.e.*, this appendix is empty).

APPENDIX C - RELATED PROCEEDINGS

No other appeals or interferences are known to Appellants or Appellants' legal representative which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal. The present application has not been assigned to any other party.

Therefore, there are no copies of decisions rendered by a court or the Board to attach (*i.e.*, this appendix is empty).